

REMARKS

Applicant is in receipt of the Office Action mailed September 6, 2005. Claims 4, 11, and 18 have been cancelled. Claims 1, 8, and 15 have been amended. Thus, claims 1-3, 5-10, 12-17, and 19-21 are pending in the case. Reconsideration of the present case is earnestly requested in light of the following remarks.

Section 102 Rejections

Claims 1, 4-8, 11-15, and 18-21 were rejected under 35 U.S.C. 102(e) as being anticipated by Fallentine et al. (US Publication 2002/0042832, "Fallentine"). Applicant respectfully disagrees.

As the Examiner is certainly aware, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Amended claim 1 recites:

1. A method for performing IP telephony, comprising:
 - registering a first Media Gateway with a Media Gateway Controller, wherein said registering the first Media Gateway comprises receiving and storing the public IP address of the first Media Gateway;
 - registering a second Media Gateway with the Media Gateway Controller, wherein said registering the second Media Gateway comprises receiving and storing the public IP address of the second Media Gateway;
 - the Media Gateway Controller receiving a Call Setup request, wherein the Call Setup request comprises a source IP address and a destination telephone number;
 - the Media Gateway Controller selecting the first Media Gateway based on the source IP address;

the Media Gateway Controller selecting the second Media Gateway based on the destination telephone number;

the Media Gateway Controller comparing a public IP address of the first Media Gateway to a public IP address of the second Media Gateway;

if the public IP address of the first Media Gateway is the same as the public IP address of the second Media Gateway, the Media Gateway Controller selecting a private IP address of the first Media Gateway and a private IP address of the second Media Gateway for Call Setup; and

if the public IP address of the first Media Gateway is not the same as the public IP address of the second Media Gateway, the Media Gateway Controller selecting the public IP address of the first Media Gateway and the public IP address of the second Media Gateway for Call Setup.

The Office Action asserts that Fallentine teaches all the limitations of amended claim 1. However, Applicant submits that there are numerous aspects of amended claim 1 not taught or suggested by Fallentine.

Fallentine nowhere teaches or suggests a Media Gateway Controller with the functionality claimed. For example, nowhere does Fallentine teach or suggest “registering a first Media Gateway with a Media Gateway Controller, wherein said registering the first Media Gateway comprises receiving and storing the public IP address of the first Media Gateway”, nor “registering a second Media Gateway with the Media Gateway Controller, wherein said registering the second Media Gateway comprises receiving and storing the public IP address of the second Media Gateway”.

Rather, as described in cited paragraph [0047], in Fallentine’s system, users register with an Internet directory assistance service (which operates as a peer in the network), such as a publicly available Internet Locator Service (ILS), which is then accessed by Fallentine’s “Glasses” H.323 gatekeeper software over the network to retrieve the public IP addresses of the devices involved with the call, as illustrated in Figures 1, 3, 6, 7, and described throughout Fallentine. In other words, Fallentine’s H.323-based gatekeeper (Glasses) operates cooperatively with a peer-to-peer service over

the network that manages user (IP-telephone) registration and provides public IP addresses to the gatekeeper upon request.

In direct contrast, in the present invention as represented in amended claim 1, a single entity, specifically, a Media Gateway Controller, performs registration, Call Setup, Media Gateway selections, and public/private IP address comparison and selection, to facilitate IP telephone calls. Note that such centrally located functionality allows local control of all these functions, whereas in Fallentine's system, peer-to-peer requests for critical information (caller/callee public IP addresses) are made to an external entity (an Internet directory assistance service), which is quite different.

Thus, Fallentine fails to teach or suggest all of the features and limitations of claim 1.

Thus, for at least these reasons, Applicant submits that claim 1 and those claims dependent therefrom are patentably distinct and non-obvious over Fallentine, and are thus allowable. Claims 8 and 15 include similar limitations as claim 1, and so the above arguments apply with equal force to these claims. Thus, for at least the reasons provided above, claims 8 and 15, and those claims respectively dependent therefrom, are patentably distinct and non-obvious over Fallentine, and are thus allowable.

Removal of the section 102 rejection of claims 1, 4-8, 11-15, and 18-21 is earnestly requested.

Section 103 Rejections

Claims 2-3, 9-10, and 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fallentine. Applicant respectfully disagrees.

First, Applicant notes that since claims 2-3, 9-10, and 16-17, depend respectively from claims 1, 8, and 15, which were shown above to be allowable, these claims are similarly allowable.

Moreover, regarding claim 2, the Office Action admits that Fallentine fails to disclose "sending the selected IP address of the first Media Gateway to the second Media Gateway", but asserts that it would have been obvious to modify Fallentine to include

this feature, suggesting the motivation “to allow call communication set-up to be established between end-points in both directions”.

Applicant respectfully notes that to establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In *re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In *re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” In *re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

As cited paragraph [0058] of Fallentine describes:

...A method for placing an ILS call from a first internal EnVision.TM. node to a second internal EnVision.TM. node may include: (1) ***internal EnVision.TM. A1 looking up the address for EnVision.TM. A2 using ILS A***; (2) EnVision.TM. A1 requesting permission from Glasses A to place a call to the IP address of EnVision.TM. A2; (3) ***Glasses A*** recognizing that EnVision.TM. A2 is a registered, internal EnVision.TM. node and that the IP address for EnVision.TM. A1 and EnVision.TM. A2 on ILS A are the same, approving the request, and ***sending the correct (private) IP address of EnVision.TM. A2 back to EnVision.TM. A1***; (4) EnVision.TM. A1 calling EnVision.TM. A2 using the correct (private) IP address; (5) EnVision.TM. A2 requesting permission to accept the call from Glasses A; (6) Glasses A approving the call between EnVision.TM. A1 and EnVision.TM. A2; and (7) the call proceeding between EnVision.TM. A1 and EnVision.TM. A2. (*emphasis added*)

As may be seen, the cited text discloses the caller (EnVision A1) accessing ILS A to retrieve the (public) address of the callee (EnVision A2), requesting permission from the gatekeeper (Glasses A) to make a call to the retrieved IP address of the callee, and the gatekeeper (upon determining that both the caller and callee are internal to the network)

sending the correct private IP address of the callee to the caller. In other words, the gatekeeper (Glasses A) sends the private address of the callee to the caller.

Nowhere does the cited text suggest or even hint at sending the selected IP address of the first Media Gateway (caller) to the second Media Gateway (callee). Nor does Fallentine indicate the desirability of this claimed feature. Applicant respectfully submits that the Examiner has simply modified Fallentine based on the claimed features and limitations of claim 2, i.e., using Applicant's claimed invention as a blueprint, which is improper, given that no "clear and particular" showing of a suggestion, teaching, or motivation to modify Fallentine has been provided. Rather, the Examiner's suggested motivation, "to allow call communication set-up to be established between two end-points in both directions" is simply a perceived benefit from including Applicant's claimed feature in the system of Fallentine, which is improper.

Thus, Applicant respectfully submits that the Examiner's attempt to modify Fallentine is improper, and so may not be used to make a prima facie case of obviousness.

Moreover, even were Fallentine properly modifiable, which Applicant argues it is not, the modification would still not produce Applicant invention as claimed, as argued above.

Thus, for at least these reasons, Applicant submits that claim 2 and those claims dependent therefrom are patentably distinct and non-obvious over Fallentine, and are thus allowable. The above arguments are equally applicable to claims 9 and 16, which include similar limitations as claim 2. Thus, for at least the reasons provided above, claims 9 and 16, and those claims respectively dependent therefrom, are patentably distinct and non-obvious over Fallentine, and are thus allowable.

Removal of the section 103 rejection of claims 2-3, 9-10, and 16-17 is earnestly requested.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5686-00500/JCH.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

Respectfully submitted,



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